

REMARKS

The Examiner is sincerely thanked for his time and helpful advice during the telephonic interview which took place on August 16, 2007.

Claims 1, 2, 4 and 5 are currently pending and have been rejected. Claim was rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Additionally, Claims 1, 2, 4 and 5 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 4,607,476 to Fulton, Jr. (hereinafter "Fulton").

According to the Examiner, Claim 4 is directed to two different embodiments and there is no support in the specification for combining the embodiments in a single claim. Additionally, Claims 1, 2 and 4 were rejected under 35 U.S.C. §112, second paragraph for use of the indefinite term "optionally."

Via this amendment, Claims 1, 2 and 4 are amended herein to replace "optionally" with "or" in accordance with currently acceptable U.S. Patent Office practice. No new matter is added via this Amendment.

Turning to the 35 U.S.C. § 112, second paragraph rejection of Claim 4, the Examiner maintains that Claim 1 is the embodiment of Figures 6 and 6a. Claim 4, which is the embodiment of Figures 7, 7a-9, and 9a cannot both be dependent and provide an alternative embodiment.

Via this Amendment, Applicants have amended Claim 4 to independent status thereby obviating this rejection. Support is found in former Claim 1. No new matter is added via this amendment.

Applicants submit that these amendments obviate the 35 U.S.C. § 112, second paragraph rejection. Withdrawn thereof is respectfully requested.

Turning to the 35 U.S.C. § 103(a) rejection, the Examiner states that Fulton discloses the claimed invention but does not disclose that the load is a roll of web material, and the second (or third) wrapping is wound after the step of moving the roll rotation station. According to the Examiner, it would have been obvious at the time Applicant's invention was made, to have modified Fulton so that it will carry a load of a roll of web material.

Applicant's traverse this rejection. Fulton is directed to stretch film wrapping material whereas the present invention is directed to paper type of wrapping material. Using the device of Fulton where the rolled material is stretched with paper, as in the present invention, renders Fulton inoperable as paper will tear when stretched. Therefore, Fulton teaches away from the present invention. Such teaching away is indicative of non-obviousness and cannot serve as a predicate for a *prima facie* case of obviousness. See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001).

The claims of the present invention currently are directed to "web material such as rolls of paper. To clarify that the present invention is directed to paper-based web material, Claims 1 and 4 have been amended to include this feature. Support for this amendment is found in the present specification at the Abstract, paragraphs [0021] and Figure 1 which shows a paper roll having a paper wrapper and original Claim 1 which stated "Method for packaging rolls, particularly paper web rolls....."

Fulton, on the other hand, is directed to a method for stretch wrapping unstable loads that will not stack without side support. The stretch wrapping of Fulton is applied to an unstable load via a rotating turntable. That is, the stretch film wrapping material is continuously spirally wound over the unstable loads. This turntable operates vertically. At Column 3, lines 25-30 of Fulton, it states, “Apparatus for wrapping an unstable load with stretch film comprising: (a) means for dispensing said film in a **vertical** plane to wrap said film about said load: (b) means for rotating said load about a **vertical** axis to wrap said film about said load.” Unlike Fulton, the present invention operates horizontally. Working in a horizontal direction, the present invention forms a nip between the roll of web material and the rotating rollers. No such nip is found in the Fulton method. Moreover, the paper web-based material of the present invention is long cylindrical and solid (stable) loads. The “palletized unstable load” of Fulton is not capable of use in a horizontal position. The differences in operating positions are clearly observable by comparing the Figures of Fulton with those of the present invention. At least for these reasons, Fulton teaches away from the present invention and cannot render same obvious.

Via this Amendment, Applicants have amended Claims 1 and 4 to indicate that the roll rotation rotates horizontally, further distinguishing the present invention from Fulton. Support for this Amendment is found at Figures 12 and 13 which shows the roll on the rolling station in a horizontal manner/position. The roll cannot be rolled and the wrapping cannot happen in any other position than in

a horizontal position on the rolling station. No new matter is added via this amendment.

Thus, for the reasons given herein, it is respectfully submitted that the present case is in condition for allowance, which action is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any other fee due with this paper may also be charged to Deposit Account No. 50-1290.

Respectfully submitted,

/Martha M. Rumore/
Martha M. Rumore
Reg. No. 47,046
(212) 940-6566

CUSTOMER NUMBER 026304
DOCKET NO.: HEIN 18.938 (100720-00050)